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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,350	06/23/2003	Jia-Hao Xiao	3774.1061-001	7786
21005	7590	03/22/2006	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.			MACIAS, CHANDA L	
530 VIRGINIA ROAD			ART UNIT	
P.O. BOX 9133			PAPER NUMBER	
CONCORD, MA 01742-9133			1643	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/602,350

Applicant(s)

XIAO ET AL.

Examiner

Chanda L. Macias

Art Unit

1643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

### **DETAILED ACTION**

1. Claims 1-13 are pending in the application and are currently subject to restriction.

#### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12, drawn to a method for inhibiting the proliferation of a eukaryotic cell whose growth is stimulated by  $\beta$ -catenin-mediated gene transcription, by administration of an expression vector encoding a non-endogenous source of RXR protein classified, for example, in class 514, subclass 44.
  - II. Claim 13, drawn to a method for determining whether a test compound is an RXR agonist, classified, for example, in class 435, subclass 7.1.
3. The inventions of Groups I and II are unrelated or otherwise patentably distinct for the following reasons:

The invention of Groups I is a method for inhibiting the proliferation of a eukaryotic cell whose growth is stimulated by  $\beta$ -catenin-mediated gene transcription, whereas the invention of Groups II is a method for determining whether a test compound is an RXR agonist.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. See MPEP §§ 806.04 and 808.01. The instant specification does not appear to disclose that any of the inventions of Groups I and II are useable together. Therefore, because the inventions of Groups I and II have different purposes, the inventions appear unrelated.

If not unrelated, the inventions of Groups I and II are patentably distinct, each from the others, for the following reasons:

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Again, the inventions of Groups I and II have different purposes or objectives. The purpose of Group I relates to a method of inhibiting proliferation of a eukaryotic cell whose growth is stimulated by  $\beta$ -catenin-mediated gene transcription. The purpose of Group II relates to a method for determining whether a test compound is an RXR agonist. Inhibiting proliferation is distinctly different from determining whether a test compound is an RXR agonist.

In addition, the inventions of Groups I and II are materially different processes comprising different process steps. The method of Group I is different from the method of Group II. For example, the material necessary to inhibit cellular proliferation would be different from the material necessary to determine if a test compound is an RXR agonist.

Because the inventions of Groups I and II are distinct for these reasons, the search required to examine claims directed to any one of these inventions is not the same, nor is it coextensive with the search required to examine claims directed to any other. Furthermore, the inventions of Groups I and II have acquired a separate status in the art, as evidenced by their different classifications and/or art-recognized divergence in subject matter. Because different searches would have to be performed to examine claims directed to the inventions of Groups I and II, an examination of both would constitute a serious burden.

Since the inventions of Groups I and II have been shown to be patentably distinct, and because the examination of both inventions could not be made without serious burden, it is proper to restrict each from the other. See MPEP § 803.

4. Because these inventions are distinct for the reasons given above and also because the search required for any one group is not required for any other group and/or the inventions have acquired a separate status in the art as shown by their different classification or their recognized divergent subject matter, searching more than one invention encompassed by the claim would constitute a serious burden; therefore, restriction for examination purposes as indicated is proper.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

**Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanda L. Macias whose telephone number is (571)272-9032. The examiner can normally be reached on Monday - Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on (571)272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chanda L. Macias, Ph.D.

Examiner

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STEPHEN RAWLINGS  
PRIMARY EXAMINER  
ART UNIT 1643

clm

March 9, 2006